

## REMARKS

### Claim Objections

Claims 24 and 58 were objected to under 37 C.F.R. 1.75(b) as being duplicate claims. The Examiner states that the Applicants are required to cancel one of the claims or amend the claim(s).

Applicants have cancelled claims 24 and 58, thus making this objection moot.

### Claim Rejections – 35 U.S.C. §112

Claims 23 and 45 remain rejected to and claim 6, 28, 29, 46-48, and 53-57 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons of record stated in the Office Action cited July 29, 2002 under item 11 wherein the Examiner states the term "relative", "very good", "moderate", "above average", "substantial degree", and "particularly suited" are relative terms that have no definite meaning. The terms do not reasonably apprise one of the scope of the invention. It is not clear what type of yield (i.e., grain yield, pollen yield, seed yield, etc.) is referred to by the recitation "very good yield". Applicants argument that the recitation of "92B84" in front of the term traits clearly indicates that the traits must be originating from 92B84 has been found non-persuasive because the specification does not teach that the traits and tables 1-2 can be described in this manner.

The Examiner also states the recitation of "50% of its alleles" does not affect the issue raised in this rejection. That the claimed plants are to express a combination of two traits that are also expressed by 92B84 also does not overcome the rejection, as it is not clear what separates a plant having, for example, moderate Sudden Death Syndrome tolerance from good or very good

tolerance. Moreover, it remains unclear how one would differentiate, for example, a substantial degree of glyphosate resistance from a good degree.

Applicants have amended claim 6. Applicants have cancelled claims 23, 28, 29, 45-48, and 53-57, thus alleviating this rejection.

The Examiner states in claims 6 and 28, there is improper antecedent basis for "protoplasts" in line 1 of the claims. The Examiner suggests that the term can be removed from the claims, and that a new claim be introduced directed towards protoplasts produced from the tissue culture of claims 5 or 27.

Applicants have amended claim 5 to provide proper antecedent basis for claim 6. Applicants have cancelled 28, thus alleviating this rejection.

The Examiner states in claims 23, 45, 55, and 56, the recitations "derived at least 50% of its alleles" in claims 23 and 45, "deriving 50% of its alleles" in claim 55, and "deriving at least about 50% of its alleles" in claim 56 renders the claim indefinite. It is not clear what is meant by "derived" and "deriving". The Examiner asks have the alleles been transformed into the claimed plants, did the claimed plants inherent the claimed alleles, etc.?

Applicants have cancelled claims 23, 45, 55, and 56, thus alleviating this rejection.

The Examiner states in claim 29, the claim recites the recitation "the tissue culture of claim 24". There is insufficient antecedent basis for this limitation in the claim or claim 24.

Applicants have cancelled claim 24, thus alleviating this rejection.

The Examiner states in claim 46, the claim is indefinite because the recitation "comprising" in line 1 does not clearly indicate how many crosses are to be performed by the method. It is suggested that the recitation --F1 hybrid-- be inserted in claim 46, lines 1 and 6, after "92B84-derived".

Applicants have cancelled claim 46, thus alleviating this rejection.

The Examiner states in claim 57, the recitation "further comprising applying double haploid methods" in lines 1-2 renders the claim indefinite. The recitation broadens the scope of parent claim 53, which only involves crosses and does not encompass any double haploid method. It is also unclear what double haploid method is being referred to.

Applicants have cancelled claim 57, thus alleviating this rejection.

The Examiner states that claim 53, the term "comprising" in part (a) of the claim renders it indefinite. It is not clear what obtaining a seed that "comprises" a plant means.

Applicants have cancelled claim 53, thus alleviating this rejection.

Claims 10, 12, 15-23, 32, 34, 37-45, and 47-49 remain rejected to and claims 8, 9, 30, 31, 46, and 50-57 were rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time that the application was filed, had possession of the claimed invention, for reasons of record stated in the Office Action mailed July 29, 2002 under item 12, which refers to the Office Action of December 18, 2001, under item 5, which states in part, the specification does not describe any of the plants derived from the breeding programs, or all tissue cultures derived from plants parts of soybean variety 92B84. It is well known that chromosome aberrations can be a side effect of tissue culture techniques, which would introduce new characteristics into the tissue culture and in plants regenerated therefrom. The specification does not describe the characteristics of such cultures and plants. In addition, the Examiner states the specification also does not describe the plants that can be produced by the soybean breeding programs or by crosses wherein one ancestor is soybean variety 92B84 or a

plant having all the physiological and morphological characteristics of soybean variety 92B84, wherein the claimed plant is separated from the parent by multiple generations. The description of 92B84 is not indicative of the description of the plants produced by the breeding programs or crosses, as other soybean plants, of unknown genotypes and phenotypes, would be crossed with 92B84 and its progeny. Additionally, to indicate that a plant expresses two 92B84 traits is not a sufficient description of the plant. As numerous plants express traits that are also expressed by 92B84, it is possible that the claimed plant inherited the genes governing those traits from one ancestor other than 92B84. Further information concerning the genotype of 92B84 may distinguish the claimed plants from others expressing at least two 92B84 traits. Such information would indicate that the genetic information governing the expression of the traits had to be derived from 92B84. However, the specification does not provide any description of the genes, molecular markers, etc. of 92B84.

Presently, the Examiner states that the methods of making a product do not describe the morphological and physiological traits of the product itself. Further, the claimed tissue cultures are not subject to this rejection. Moreover, the Examiner states, the specification does not describe any of the alleles of 92B84, and does not describe which of the alleles of any of the claimed progeny plants were inherited from 92B84. The specification does not correlate any function with any of the alleles of 92B84. The specification does not describe the alleles that govern the expression of any of the traits listed in the claims as the alleles of 92B84 are not described, neither are the alleles of its descendants. Further, as plant 92B84 is crossed with other plants to produce the claimed progeny plants, the progeny plants will not possess all of the unique germplasm that forms 92B84. Furtherstill, the claimed plants will also inherit 50% of its

alleles from the other parent, and no description is provided at all concerning any of their morphological and physiological traits.

The morphological and physiological description of 92B84 does not provide any information concerning all of the morphological and physiological description of hybrid progeny of 92B84. Further, the specification does not describe any double haploids methods.

Applicants have amended claims 8 and 9. Applicants have cancelled claims 10, 12, 15-23, 30, 31, 32, 34, 37-45, 46, and 47-49, thus alleviating this rejection.

**Claim Rejections – 35 U.S.C. § 102 and/or § 103**

Claims 10, 17, 21, 22, 32, 40, 44, 49, 50, and 52 remain rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Stieger et al. (U.S. Patent No. 6, 153, 816), for reasons of record stated in the office action dated July 29, 2002 under item 14.

Applicants have cancelled claims 10, 17, 21, 22, 32, 40, 44, 49, 50, and 52, thus alleviating this rejection.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



HEIDI S. NEBEL, Reg. No. 37,719  
McKEE, VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
Phone No. (515) 288-3667  
Fax No. (515) 288-1338  
**CUSTOMER NO: 27142**

Attorneys of Record

- mlw -

RECEIVED  
CENTRAL FAX CENTER

OCT 06 2003

OFFICIAL